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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
WORJLOH, JALATTEE				
ART UNIT		PAPER NUMBER		
3685				
NOTIFICATION DATE		DELIVERY MODE		
01/15/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/926,360

Applicant(s)

PAILLES ET AL.

Examiner

Jalatee Worjloh

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 23-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No./Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 1, 2008 has been entered.
2. Claims 23-37 are pending.

Response to Arguments

3. Applicants' arguments filed December 1, 2008 have been fully considered but they are not persuasive.
4. Applicants argue "communicatively" and "operably" are not relative terms. However, the Examiner respectfully disagrees. As expressed in the Office Action, these terms do not clearly define the scope of the claim. These terms do not precisely express if the storage device and the payment means are linked to the terminal.
5. Applicants argue that Downs does not teach a payment system is provided for controlling the continued use of a software program by a user. However, this feature is recited in the preamble and has not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*,

535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

6. Applicants argue that Downs does not teach a software is providing an interface offering continued utilization of the software in exchange for payment from the user. However, the Examiner respectfully disagrees. The Digital Content Store is a website that offers content to the user. Once the user purchases the content, he has "continued utilization of the software".

7. As per claims 24-35, Applicants arguments are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 112

8. Claims 23-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The term "communicatively" in claim 23 is a relative term which renders the claim indefinite. The term "communicatively" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term, communicatively, does not clearly define the scope. Is the storage device linked or not?

10. The term "operably" in claim 1 is a relative term which renders the claim indefinite. The term "operably" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term, operably, does not clearly define the scope. Is the payment means linked or not linked to the terminal?

11. Claims 23 recites the limitation "the identity of the user" in line 11. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 23 is a considered hybrid claim. See MPEP §2173.05(p) II.

In particular, the claims are directed to neither a "process" or a "machine" but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.. For example, claim 23 recites "A payment system." In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicant(s) to claim a product claim. Alternatively, claim 23 also recites "software providing" One of ordinary skill in the art could also reasonably interpret these recitations as express intent by Applicant(s) to claim a process claim. In light of this conflicting evidence, a person of ordinary skill in the art could reasonably interpret claim 23 to be drawn to both a product or process.

Therefore in accordance with §2173.05(p) II which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of Applicant(s) would not know whether *possession alone* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited method steps, the claims are indefinite. If Applicant(s) overcome this particular 35 U.S.C. §112, 2nd paragraph rejection, the related 35 U.S.C. §101 rejection will also be withdrawn. For examination purposes, the Examiner will interpret claims 23-35 as claims directed to a product only.

13. Claim 24 recites the limitation "the root of the certification tree" in line 4. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 25 recites the limitation "the total consumption" in lines 5 and 6. There is insufficient antecedent basis for this limitation in the claim.
15. Claim 27 recites "reader and card are able to receive the second message, check the proof of the user acceptance, record the payment request and compose the third message, payment settlement, with the proof of payment"; however, it is unclear what is happening in this step. That is, is the payment settlement being performed after the third message is composed? Is a proof of payment given?
16. Claim 29 recites the limitation "the prepay card message" in line 2. There is insufficient antecedent basis for this limitation in the claim.
17. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Claim 30 recites "whereby a payment settlement message is only sent with a corresponding digital signature once this file has been updated"; however, the element of updating the file is not recited in the claim.
18. Claim 31 recites "the prepay card can be topped up"; however, the meaning of "topped up" is unclear. Therefore, for examination a process, this term is being interpreted as loading additional funds.
19. Claim 33 recites the limitation "the post-pay type" in line 2. There is insufficient antecedent basis for this limitation in the claim.
20. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Claim 30 recites "whereby a payment settlement message is only sent with a

corresponding digital signature once this file has been updated"; however, the element of updating the file is not recited in the claim.

Claim Rejections - 35 USC § 101

21. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

22. Claims 23-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

23. As per claims 23-35, 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added). The applicants claims mentioned above are intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a system, but subsequently the claims then deal with the specifics of a method (the steps) executed by the processing means (see above rejection of claims under 35 USC 112, second paragraph, for specific details regarding this issue). "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

Claim Objections

24. Claims 24, 29 and 35 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

25. Claim 24 recites "The system in accordance with claim 23, whereby the digital signature of the owner of at least part of the offer and the digital signature for proof of payment are both public key signatures with certification trees..."; however, this does not limit the components of the system. That is, these elements do not limit the terminal, the payment means, or the message and payment processing server.

26. Claim 29 recites "whereby the prepay card message is..."; however, this does not limit the components of the system. That is, these elements do not limit the terminal, the payment means, or the message and payment processing server.

27. Claim 35 recites "whereby the file is transferred to the remote payment server for transferring funds to the software owners".

Claim Rejections - 35 USC § 102

28. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

29. Claims 23-26, 36 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6226618 to Downs et al. ("Downs").

Referring to claim 23, Downs discloses a terminal configured to access software from a computer readable storage communicatively linked thereto the software providing an interface offering continued utilization of the software in exchange for payment from the user, the

interface providing at least an identity of the software owner, offer parameters and the digital signature of the owner for at least part of the offer, and configured to generate a first message (see col. 18 table, steps 130-135; col. 7, lines 56- 67 - the digital content store offers the digital content which is part of the content SC; the license key allows the user continues use of the content), payment means operably linked to the terminal and configured to receive the first message, display the first message, receive a potential acceptance of the software user, compose a second message requesting payment which includes at least the identity of the user, and of the software owner together with proof of the user acceptance, and configured to transmit the second message (see col. 18, step 136 - the user adds the digital content to his shopping card and submits it), a message and payment processing server (i.e. clearinghouse) configured to receive the second message, verify the existence of the proof of user acceptance, record the payment request with at least the identity of the user and of the software owner and the amount to be paid, credit the owner with the amount to be paid, configured to compose a third message which serves as a payment settlement message, the third message containing at least the identity of the message and payment processing server and a digital signature for proof of payment, and transmitting the third message therefrom (see col. 19, steps 137 & 138; col. 23, lines 56-67; col. 24, lines 1-4 - transaction SC & Offer SC).

Referring to claim 24, Downs discloses the system whereby the digital signature of the owner of at least part of the offer, and the digital signature for proof of payment are both public key signatures with certification trees, whereby an authority defines the root of the certification tree containing the system's different participants, notably the software owner and the message and payment processing server, and whereby one or more certificates are attached to the first and

third message for signature checking (see col. 13 & col. 14 - "Digital Signatures" and "Digital Certificates").

Referring to claim 25, Downs discloses whereby the message and payment processing server further comprises: a remote payment server linked to the payment means by a telecommunications network, and whereby said remote payment server receives and processes the second message and composes and sends the third message; the remote payment server calculates the total consumption of each user for all software owners in order to impose payment by said user and causes the sums owned to each software owner to be transferred by all of the users.

Referring to claim 26, Downs discloses whereby the message and payment processing server further comprises secure means containing at least the identity of the user; said means are additionally able to receive the second message, check the proof of the user acceptance, record the payment request and compose the third message, payment settlement, transfer the third message, and also includes a remote payment server able to credit the software owner (see claim 23 above).

Claims 36 and 37 are rejected on the same rationale as claim 23 above.

Claim Rejections - 35 USC § 103

30. Claims 27-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs as applied to claim 26 above, and further in view of US Patent No. 6105008 to Davis et al. ("Davis").

Referring to claims 27-31, Downs discloses the feature of claim 26. However, Downs does not expressly disclose the secure means include a smart card reader with a smart card

containing the user's identity, and whereby the reader and card are able to receive the second message, check the proof of the user acceptance, record the payment request and compose the third message, payment settlement, with the proof of payment. Davis discloses a secure means include a smart card reader with a smart card containing the user's identity, and whereby the reader and card are able to receive the second message, check the proof of the user acceptance, record the payment request and compose the third message, payment settlement, with the proof of payment, whereby the card is of a prepay type and contains a balance and whereby the card is able to debit the balance with the request amount at each payment request, whereby the prepay card message is able to insert into the third message proof that the requested amount has been debited from the card, whereby the prepay card is able to build a file containing settled requests and corresponding amounts, and whereby a payment settlement message is only sent with a corresponding digital signature once this file has been updated, whereby the prepay card can be topped up and whereby the file is first transferred to the remote payment server during the topping-up process, for transferring funds to the software owners (see abstract & col. 7, lines 53-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the Downs to include the features of Davis. One of ordinary skill in the art would have been motivated to do this because it prevents fraud by ensuring that only confirmed payments are settled.

Referring to claim 32, Downs discloses the system of claim 28. Downs does not expressly disclose a wallet. Davis discloses the prepay card is of the electronic wallet type (see col. 7, lines 40-50). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Downs to include a wallet. One of

ordinary skill in the art would have been motivated to do this because it wallets are an efficient means of storing user's payment information, certificate and shipping information for fast transactions.

Referring to claim 35, Downs discloses whereby the file is transferred to the remote payment server for transferring funds to the software owners (see claim 23 above).

Conclusion

31. Functional recitation(s) using the word “for” or other functional language (e.g. “in order to”, “able to”) have been considered but are given little patentable weight¹ because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

32. Although the conditional elements have been considered, Applicant is reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See MPEP §2106 II. C: “Language that suggests or makes optional but does not require steps to

¹ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that

be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]"

33. "A whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and 571-273-6714 for Non-Official /Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

although all limitations must be considered, not all limitations are entitled to patentable weight).

Art Unit: 3685

/Jalatee Worjloh/

Primary Examiner, Art Unit 3685